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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/994,059

11/27/2001

Jacques Quellais

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03/08/2005

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EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/994,059	<b>Applicant(s)</b> QUELLAIS ET AL.	
	<b>Examiner</b> Marie Patterson	<b>Art Unit</b> 3728	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2004 and 07 February 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16, 18, 20, 21, 23 and 25-27 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 18, 20, 21, 23 and 25-27 is/are rejected.
- 7) ☒ Claim(s) 15 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

1. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 depends from a canceled claim 17 rendering the claim vague and indefinite and it is not clear what structural limitations applicant intends to encompass with such language. The limitations of claim 18 would appear to contradict the limitations of claim 1 and therefore it is not clear what claim applicant would consider 18 to depend from.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily

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published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 20, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Salzman (4186500).

Salzman shows a sole comprising a ground contacting layer (11) which is molded and forms arc shaped stops at the toe and heel portions in "recesses" of an intermediate layer (30) which covers "the entire" ground contacting surface, and a comfort layer (50) inasmuch as the claims are understood.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4-14, 18, 21, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misevich (4854057) in view of Hannibal (4651445).

Misevich shows a shoe comprising a laminated sole comprising a ground contacting layer (formed by a tread 32 and cushioning 46, also note column 10 lines 9-15), a comfort layer (44), and an intermediate layer (37) substantially as claimed except for the intermediate layer covering the entire surface of the ground contacting layer and/or the intermediate layer comprising a succession of rigid inserts. Misevich clearly states that

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the "midsole" (33) "can be manufactured with two separately formed foamed layers, and these layers may have different densities" (column 10 lines 9-15), which results in the lower layer (46) being part of the ground contacting layer and the top foamed layer being the comfort layer (44). Misevich also clearly suggests "various factors associated with the stiffening formation of this invention may be suitably varied depending upon the circumstances. For example, such factors as the thickness of the stiffening formation, the stiffness of the formation, the geometrical extent or area covered by the stiffening formation, and the placement height of the formation may all be varied to accomodate different running styles, let and foot asymmetries and body weights" (column 10 lines 37-46). Hannibal teaches extending a substantially rigid support layer (30) to cover the entire surface of a ground contacting layer. It would have been obvious to extend the intermediate support layer to cover the entire surface of the ground contacting layer as taught by Hannibal in the shoe sole of Misevich to increase the geometrical extent/area covered by the stiffening formation as suggested by Misevich to increase the support/stiffness in the forefoot area of the shoe.

In reference to claims 5-10, Misevich as modified above discloses the claimed invention except for the exact materials. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the materials claimed, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In *re Leshin*, 125 USPQ 416.

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intermediate support layer to cover the entire surface of the ground contacting layer as taught by

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 2, 4-14, 18, 21, and 25 above, and further in view of Banich.

Misevich as modified above shows a shoe sole substantially as claimed except for the comfort layer having different areas of elasticity. Banich teaches providing a midsole (figure 4) having zones of different material properties. It would have been obvious to provide the comfort layer with zones as taught by Banich in the shoe sole of Misevich as modified above to improve stability and natural biomechanics of the foot.

6. Claims 23, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 2, 4-14, 18, 21, and 25 above, and further in view of Kurrash (4580359).

Misevich as modified above shows a shoe sole substantially as claimed except for the intermediate support layer including means for attaching tread elements. Kurrash teaches providing means for attaching tread elements/skids (44) on a rigid intermediate layer (42) of a sole. It would have been obvious to provide means for attaching tread elements/skids as taught by Kurrash on the rigid intermediate layer of the sole of Misevich as modified above to allow the use of different traction elements.

7. Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

8. Applicant's arguments filed 12/20/04 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards Salzman, the insert of Salzman clearly extends over the entire surface as shown in figures 3 and 6 in view of the specification as described as such in the specification (specifically in the brief description of the drawings). The insert 30 is rigid (see column 2 lines 55-59 and it is clearly shown as covering the entire layer in the drawings. Since it provides torsion rigidity (column 2 lines 55-60, as applicant has argued it must/inherently cover the width of the shoe sole. Also, in figure 3 of Salzman clearly shows portions of the plate as discussed in column 3 lines 1-20 which extends over the entire width of the shoe sole. The sole of Salzman would not function and would not be formed with holes as described if the insert did not extend over the entire surface of the ground contacting layer.

In response to applicants' argument that claim 1 requires the ground contacting layer be made from rubber, this is not true, the only recitation of rubber in claim 1 is in a statement of what is permitted by the structures, i.e. the framework "thereby permitting it to be made of soft, more adherent rubber", there is no positive recitation that any element is made of rubber, only that a structure is present so as to allow such a use.

In response to Applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as

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here, the rejections are based on combinations of references. In re Keller, 208 USPQ 871 (CCPA 1981).

In response to applicants' arguments directed towards the teachings of Hannibal, Hannibal clearly discloses a stiffening layer of a composite/laminate sole which extends over the entire surface of the ground contacting layer of the sole. Hannibal also clearly teaches that the exact placement of the layer does not appear to be exclusive to the location shown ( as suggested in column 7 lines 55-63). Hannibal clearly teaches extending a stiffening layer over the entire surface area of a sole. The exact location of the stiffening layer is clearly shown and disclosed by the base reference to Misevich.

### ***Reissue Applications***

9. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

10. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 23, 26, and 27 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:



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"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

**Conclusion**

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson  
Primary Examiner  
Art Unit 3728